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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92044538
Party	Defendant ONFOLIO, INC. ONFOLIO, INC. FOUR CAMBRIDGE CENTER 3RD FLOOR CAMBRIDGE, MA 02142
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Submission	Opposition/Response to Motion
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Date	09/07/2005
Attachments	Registrant's Opposition To Petitioner's Motion For Suspension of Proceedings.pdf (18 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<hr/> MISSIONTREK LTD. CO., Petitioner	}	
	}	
v.	}	Cancellation No. 92044538
	}	v.
	}	Reg. No. 2,904,982
	}	
ONFOLIO, INC.,	}	
Registrant.	}	
<hr/>	}	

**REGISTRANT’S OPPOSITION TO PETITIONER’S MOTION
FOR SUSPENSION OF PROCEEDINGS**

Registrant, Onfolio, Inc. (“Registrant”), hereby opposes Petitioner’s Motion for Suspension of Proceedings (the “Motion for Suspension”).

Procedural Background and Summary of Argument

Registrant filed its Motion for Summary Judgment on July 1, 2005. Petitioner filed its Response to Registrant’s Motion on July 25, 2005. Registrant filed its Reply to Petitioner’s Response on August 9, 2005.

In short, Petitioner has already responded substantively to Registrant’s Motion for Summary Judgment, the issues have been thoroughly briefed, and Registrant’s Motion is ready to be decided.

Nevertheless, Petitioner has now filed a last-minute Motion for Suspension. This is an obvious attempt to avoid a decision on Registrant’s Motion for Summary Judgment. Such a maneuver contravenes the express purpose of Trademark Rule of Practice 2.117(b).

In any case, Petitioner’s Motion for Suspension is based upon its filing of a cancellation action against a mark that is not owned by Registrant and which is not similar to Registrant’s mark. The grounds of this unrelated cancellation action are entirely different from the grounds which Petitioner has alleged in the instant proceeding. Registrant is not a party to Petitioner’s

other cancellation action, and the outcome of that third-party action will have no bearing whatsoever on the issues to be determined herein.

Moreover, Petitioner's Motion for Suspension is legally insufficient, since it fails to comply with the minimal requirements for such a motion. Finally, Petitioner's third-party cancellation action is itself both factually and legally groundless. Petitioner's commencement of such a frivolous action raises serious doubts regarding the good faith of its Motion for Suspension.

Argument

1. Petitioner's Motion for Suspension was Filed for the Purpose of Escaping a Decision on Registrant's Potentially Dispositive Motion for Summary Judgment, in Contravention of the Express Purpose of Rule 2.117(b)
-

Trademark Rule of Practice 2.117(a) provides that the Board may decide to suspend a pending case when it learns that a party or parties to that case are engaged in a civil action or other Board proceeding "which may have a bearing on the case." This Rule is qualified by Trademark Rule of Practice 2.117(b), which reads as follows:

Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.

The purpose of Rule 2.117(b) "is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action [or other Board proceeding] and then moving to suspend before the Board has decided the potentially dispositive motion." *Trademark Trial and Appeal Board Manual of Procedure (TBMP)* §510.02.

Registrant's pending Motion for Summary Judgment is obviously "a motion which is potentially dispositive of the case" herein. Just as obviously, Petitioner is attempting to escape that motion "by filing [another Board proceeding] and then moving to suspend before the Board

has decided the potentially dispositive motion.” *Id.* Petitioner is apparently concerned that it may lose on summary judgment and is seeking to avoid or postpone such a contingency. This is precisely the kind of stratagem that Rule 2.117(b) was designed to prevent.

Having responded substantively to Registrant’s Motion for Summary Judgment, Petitioner should not be allowed to escape a decision on that Motion due to a last-minute attack of cold feet.

II. Petitioner’s Motion for Suspension is Legally Insufficient

Petitioner’s Motion for Suspension is premised on its filing of a cancellation petition against the third-party registration of PROVISIO, Reg. No. 2,618,273. However, Petitioner has not submitted a copy of this cancellation petition. As governing precedent indicates, the Board will not decide a motion to suspend based on the commencement of another action unless the movant has submitted a copy of the pleadings from that other action. See, e.g., *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411 (TTAB 1975); *Martin Beverage Co., Inc. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971). The submission of such a copy is necessary to allow the Board to “ascertain whether the final determination of the civil action [or other Board proceeding] will have a bearing on the issues before the Board.” *TBMP, supra*.

Moreover, a movant for suspension of a case on the basis of another Board proceeding should explain how the other proceeding “may have a bearing” on the case, since this is the standard for suspension under Rule 2.117(a). Petitioner’s Motion for Suspension fails to provide any such explanation. It states in conclusory fashion that the cancellation action against the third-party mark PROVISIO “will significantly clarify issues raised in the [instant] Cancellation of the Registration of the mark ONFOLIO,” but it fails to specify which issues in the instant proceeding will be clarified, or how such clarification could possibly occur. In fact, as the next

Section will show, the cancellation action against PROVISIO cannot possibly “clarify” the issues in the instant proceeding, or otherwise have any bearing on this case.

III. The Cancellation Action Against PROVISIO Does Not and Cannot Have Any Bearing on the Instant Proceeding

In an effort to prevent further waste of time, Registrant has obtained a copy of Petitioner’s unrelated cancellation petition and is enclosing it here as Exhibit A. As noted, the mark which Petitioner is seeking to cancel in the unrelated proceeding is PROVISIO, Reg. No. 2,618,273. This registration is owned by one Chistoph Neihus. It covers “Communication software for connecting users to the global computer network, especially, for Internet terminal operations; computer software, namely web browser software.”

A. PROVISIO is Not Owned by Registrant and is Not Related or Similar to Registrant’s Mark

Registrant does not own any rights whatsoever in the mark PROVISIO, and has no relationship to the mark or to its owner Christoph Neihus. Moreover, the mark PROVISIO has no similarity to Registrant’s mark. To a U.S. customer, the mark PROVISIO would be seen as a truncation of the word “Provision.” This is certainly not the case with Registrant’s mark ONFOLIO, which is otherwise distinguishable from PROVISIO in appearance, sound and meaning.¹ The continued registration or cancellation of PROVISIO is therefore totally irrelevant to Registrant’s mark ONFOLIO.

¹ Although both ONFOLIO and PROVISIO end in “-IO,” Registrant has previously shown that the “-IO” suffix appears in literally *hundreds* of registered hardware and software marks, including marks identifying goods that are identical or related to those of Petitioner. See *Registrant’s Motion for Summary Judgment* at 2-3, Exhibits B and C thereto, and the discussion *infra*.

B. The Grounds of the Cancellation Action Against PROVISIO are Entirely Different from the Grounds of the Instant Proceeding

The instant proceedings are based upon Petitioner's claim that Registrant's mark ONFOLIO is confusingly similar to Petitioner's mark CARTAGIO. However, the cancellation petition against PROVISIO is not based upon likelihood of confusion, or upon dilution. It merely alleges the non-use and abandonment of PROVISIO. The issues raised in the cancellation action against PROVISIO are therefore totally irrelevant to the issues raised in the instant proceeding between Petitioner and Registrant.

C. Even if Successful, the Cancellation of PROVISIO Would Not Alter or Affect the Issues in the Instant Proceeding

As shown in Registrant's previous filings, PROVISIO is one of literally hundreds of registered hardware/software marks that contain the suffix "IO." Cancelling the single registration of PROVISIO would not eliminate those hundreds of other registrations; nor would it qualify their proof that the "IO" suffix is common, widely-used and non-distinctive.

Moreover, as shown by the TARR print-outs submitted as Exhibit C to *Registrant's Motion for Summary Judgment*, PROVISIO is one of several dozen "IO"-suffix marks which cover goods that are identical or related to the goods covered by Petitioner's registration of CARTAGIO.²

In short, cancelling the registration of PROVISIO would merely remove one of many relevant third-party registrations, leaving all of the others intact. Since the cancellation would be

² Petitioner's registration of CARTAGIO covers (i) Internet browser software; (ii) database management equipment; (iii) Internet cost and accounting software; and (iv) software for hosting computer servers. The registration of PROVISIO covers "web browser software," but the same or related goods are covered by the previously-submitted third-party registrations of INPERIO, Reg. No. 2,342,192 ("computer software for browsing the Internet"); PENOKIO, Reg. No. 2,802,880 ("Internet browsers"), and NETRIO, Reg. No. 2,694,733 ("computer software used to translate and customize data and information transmitted over global computer networks...accessed by businesses using commercial browser software"). Other third-party registrations previously submitted by Registrant cover database management software, servers and server software, and software used to facilitate Web-related activities.

based upon non-use and abandonment, it would not involve any of the likelihood of confusion issues which are the sole basis of the instant proceeding. Finally, PROVISIO is not owned by Registrant and is wholly unrelated and dissimilar to Registrant's mark. Consequently, the fate of PROVISIO can have no bearing whatsoever on the instant case.

IV. Petitioner's Unrelated Cancellation Action is Both Factually and Legally Groundless

The only grounds alleged by Petitioner for cancellation of PROVISIO are non-use and abandonment. As shown by the attached Exhibit A, Petitioner bases these allegations on one supposed "fact": namely, that the PROVISIO website at *www.provisio.com* does not show use of PROVISIO as a trademark for software products, but at most shows use of PROVISIO as a trade name or service mark.

Unfortunately for Petitioner, this "fact" is glaringly false, as even a cursory review of the PROVISIO website shows. Attached as Exhibits B-1 and B-2 are print-outs from that website, accessed at *www.provisio.com*. Exhibit B-1 consists of a screen from the PROVISIO software which is reproduced on the website. Exhibit B-2 consists of a section from the website permitting a customer to download the PROVISIO software. As can be seen, the mark PROVISIO appears on both of these Exhibits, and in both cases PROVISIO is used as a mark and not as a trade name. Thus, the PROVISIO website *does* show use of PROVISIO as a trademark for software, and the owner of PROVISIO has in no way "abandoned" that mark. *See Trademark Manual of Examining Procedure* §904.04(d)(4th ed. April 2005) (acceptable specimens of use for software marks include a screen of the software bearing the mark; for downloadable software, a specimen showing use of the mark on an Internet website is acceptable).

Moreover, the cancellation petition against PROVISIO is fatally flawed in that it fails to allege Petitioner's standing to seek cancellation of the mark, or any facts upon which standing could be premised. As the attached Exhibit A shows, Petitioner does not allege ownership of any mark in its cancellation petition, let alone a mark which is being actually or potentially damaged by PROVISIO. Petitioner does not allege that PROVISIO dilutes or is confusingly similar to any mark of Petitioner's, or that PROVISIO has prevented Petitioner from registering any mark, or that the registration of PROVISIO has caused or is likely to cause any other injury to Petitioner.

In fact, Petitioner will not be able to allege standing to seek cancellation of PROVISIO, for the simple reason that PROVISIO has a significantly earlier date of first use than Petitioner's mark CARTAGIO, as well as earlier filing and registration dates. An allegation by Petitioner of likely confusion (or any other substantive conflict) between PROVISIO and CARTAGIO would be a suicidal admission against interest, which would allow the owner of PROVISIO to cancel Petitioner's registration of CARTAGIO.³

The above considerations undoubtedly explain why Petitioner failed to include a count for likely confusion, dilution or other substantive harm as one of the grounds of its cancellation petition against PROVISIO. However, the rules of standing do not permit silence on the question of injury, presenting Petitioner with a dilemma that it will not be able to resolve.

Thus, Petitioner has not only failed to allege standing, but cannot allege standing. The cancellation petition against PROVISIO is therefore legally invalid, as well as factually groundless.

³ As shown above, Petitioner's belief that PROVISIO is not being used as a trademark is mistaken; and in any case, Petitioner has admitted that PROVISIO is being used as a trade name. Prior trade name use is a sufficient basis for cancelling a conflicting mark. See *West Fla. Seafood v. Jet Restaurants*, 31 F. 3d 1122, 31 USPQ 2d 1660 (CAFC 1994)(proof of prior use as a trade name is sufficient to cancel a registration); *Martahus v. Video Duplication Servs., Inc.*, 3 F. 3d 417, 27 USPQ 2d 1846 (CAFC 1993)(a trade name may bar registration of a trademark or service mark that is confusingly similar to that trade name).

CONCLUSION

Petitioner filed its Motion for Suspension to escape a decision on Registrant's Motion for Summary Judgment, in contravention of the express purpose of Rule 2.117(b). The legal and factual invalidity of Petitioner's cancellation action against PROVISIO, the unrelated nature of the issues involved in that action, the fact that PROVISIO is neither owned by Registrant nor similar to Registrant's mark, and Petitioner's utter failure (indeed, its inability) to explain how its action against PROVISIO could have any bearing on the instant proceeding--these factors not only require denial of Petitioner's Motion for Suspension, but also raise serious doubts regarding Petitioner's good faith in filing that Motion (not to mention its cancellation action against the unrelated mark PROVISIO).

Registrant therefore respectfully requests that Petitioner's Motion for Suspension be denied and that the Board proceed to render a decision on Registrant's Motion for Summary Judgment.

Date: SEPT. 7, 2005

Respectfully submitted,



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Attorneys for Registrant

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the above document was served upon the attorney of record for each other party by mail/hand/facsimile on 9-7-05

Heraldie MacFellan

EXHIBIT

A

Exhibit A

Trademark Trial and Appeal Board Electronic Filing System. <http://estta.uspto.gov>

ESTTA Tracking number: **ESTTA43051**

Filing date: **08/24/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	MissionTreck Ltd. Co.		
Entity	Corporation	Citizenship	Texas
Address	813 Palm Desert Drive Garland, TX 75044 UNITED STATES		

Attorney information	Sherman D. Pernia, Ph.D., JD Sheman D. Pernia, Esq. 1110 NASA Parkway, Suite 450 Houston, TX 77058-3346 UNITED STATES sherman@patentinfo.net Phone:281-335-4505
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Registration Subject to Cancellation

Registration No	2618273	Registration date	09/10/2002
Registrant	NIEHUS, Christoph Schulstrasse 9 Muenster, 48149 GERMANY		
Goods/Services Subject to Cancellation	Class 009. First Use: 19980201, First Use In Commerce: 19980201 Goods/Services: Communications software for connecting users to the global computer network, especially for internet terminal operation; computer software, namely, web browser software		

Related Proceedings	Opposition No. 91165315 Cancellation No. 92044538
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Attachments	tmo5.txt (2 pages)
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Signature	/Sherman D. Pernia/
Name	Sherman D. Pernia, Ph.D., JD
Date	08/24/2005

PETITION FOR CANCELLATION
MISSIONTREK LTD. CO. (Petitioner)

vs.

NIEHUS, Christoph. (Registrant)

Petitioner, MISSIONTREK LTD. CO., a Texas limited liability company of
813 Palm Desert

Drive, Garland, TX 75044, believes that it will be damaged by
Registration No. 2618273, and hereby
petitions to cancel the same.

Description of Registrant's Registration:

filed: September 27, 2000.

Registered: September 10, 2002.

Mark: PROVISIO

Class: 9 for Communications software for connecting users to the global
computer

network, especially for internet terminal operation; computer software,
namely, web

browser software.

Grounds of Cancellation:

I

A petition to cancel a mark that has been on the Principal Register
less than five years may be grounded on the allegation that the mark is
barred from registration under one of the statutory bars of Lanham Act
? 2. Designations used only as trade names are not registrable. Mr.
Christoph Niehus, Registrant, in the present procedure is Executive
Associate of PROVISIO GmbH, Germany. Accessing the site
www.provisio.com supports Petitioners present assertion that PROVISIO
is a trade name and/or service mark only, and not as a trademark for
products in class 9. PROVISIO GmbH, a German company, as well as their
Miami firm PROVISIO LLC appear to use the word PROVISIO only as a
company/trade name without indicating any product carrying that
designation. The products have unrelated names, such as "SiteKiosk
6.0", "SiteCafe 1.0", "SiteRemote", and no goods appear to be covered
by the PROVISIO designation. Under these circumstances, the mark
PROVISIO should be cancelled.

II

Non-use in commerce is a specifically enumerated ground under which a
registration may be canceled "at any time" and a ground for a petition
to cancel a mark that has been on the Principal Register less than five
years. Even if filed in the Principal Register based on a foreign
registration, an applicant must affirm the applicant's bona fide
intention to use the mark in commerce. As demonstrated above, the
Registrant is not using the mark in commerce as no products carry the
designation PROVISIO, and this mark appears at best to be the trade
name of the German and Florida companies. Therefore, Petitioner asserts
that, with respect to product class 9, Registrant has abandoned said
registered mark by its non-use thereof in connection with goods in
class 9, with no intent to resume said use.

? ? ?

THEREFORE, Petitioner prays that said Registration No. 2618273 be
cancelled, namely, that this Petition for Cancellation be sustained in

favor of Petitioner.

Petitioner hereby appoints Sherman D. Pernia, Esq., member of the bar of the State of Texas, to act as Attorney for Petitioner herein, with full power to prosecute said Cancellation, to transact all relevant business with the Patent and Trademark Office and in the United States Courts and to receive all official communication in connection with this Cancellation. Petitioner submits herewith a duplicate copy of this Notice of Cancellation and authorizes the Board to debit the account of MOETTELI & Associates SaRL, No. 502621, to cover the Board \$ 300 fee for the Cancellation.

EXHIBIT

B-1

SITEKIOSK - Startseite - SiteKiosk Internet Browser

Address www.sitekiosk.com

Favorites

Add

Software

SITEKIOSK - Startseite

Microsoft

Apple Inc.

Datenbanken

Oracle

Open Source

PostgreSQL

Lifestyle

Gucci

Joop, Wolfgang

Helmut Lang

Nicowa Modevertrieb

SiteKiosk™

New Window

Bug Report

SiteKiosk 6.0 Build 97

Version builded 2004-08-20 11:05:25

Installation Directory: C:\Programme\SiteKiosk\

You did not specify a Start Page. Please use the SiteKiosk Configuration Wizard, which you can find under **START PROGRAMS\SITEKIOSK**, to create your own configuration. Each of the individual pages of this tool provides a **HELP**-Button by means of which you can find further information concerning the corresponding dialog box.

You can adjust the browser layout and the touchscreen keyboard to your needs in ANY way you want. You will find a documentation about the SiteKiosk Object Model within the SiteKiosk help.

In order to prevent the **EXIT**-Button from being displayed in the toolbar, please choose a **PASSWORD** in the category "ESC-Password", which you will find in the Configuration Wizard. By defining a password you will also ensure that the password-dialog box will be displayed everytime the user exits SiteKiosk.

Additional Browser-Skins are available for download at www.sitekskin.com.

Please register SiteKiosk because otherwise the user will be able to exit SiteKiosk by entering any password of his or her choice.

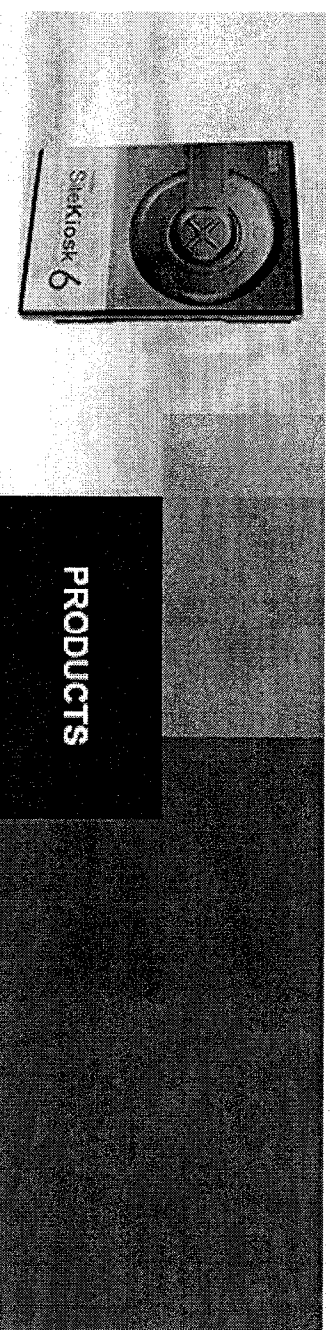
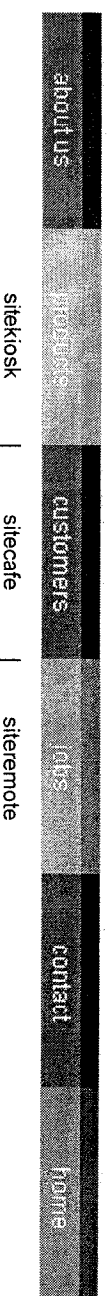
PROVISIO
SiteKiosk™
Personal software

© 1996-2004 PROVISIO LLC, USA & PROVISIO GmbH, Germany

EXHIBIT

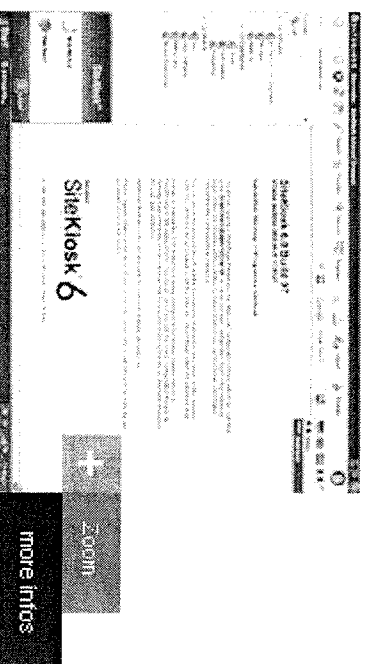
B-2

Exhibit B-2



SiteKiosk™

SiteKiosk is a complete software solution for public access computers and internet terminals.



The software SiteKiosk protects the desktop against manipulation and guarantees the maintenance-free operation of public (Internet) PCs. Each individual program can be controlled separately.

While providing the same functionality as Microsoft's Internet Explorer, the included browser disables all critical functions.

SiteKiosk's Configuration Wizard makes it possible even for less computer-savvy users to create an individual configuration within a short period of time - no programming skills required!

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Extensions

Juvenile Protection Filter [▶](#)

Photo and Video E-Mail [▶](#)

Billing by payment devices according to usage [▶](#)

SiteCafe [▶](#) SiteRemote [▶](#)

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